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# TRANSMITTAL FORM

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| Application Number | 10/616,359 |
| Filing Date | July 9, 2003 |
| First Named Inventor | Bizzarro |
| Art Unit | 1626 |
| Examiner Name | Wright, Sonya N |
| Attorney Docket Number | 20400 US6 |

Total Number of Pages in This Submission

## ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☑ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) (please Identify below):

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|---|---|
| Firm or Individual | Eileen M. Ebel |
| Signature | Eileen M Ebel |
| Date | March 4, 2004 |

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on this date March 4, 2004

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| Typed or printed | Eileen M. Ebel | | |
| Signature | Eileen M Ebel | Date | March 4, 2004 |

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Fred Thomas Bizzarro, et. al.

Group: 1626

Serial No. 10/616,359, filed July 9, 2003
Docket No.: 20400 US6

Examiner: Wright, Sonya N

For: HETEROAROMATIC GLUCOKINASE ACTIVATORS

**RESPONSE UNDER 35 U S C § 121**

Nutley, New Jersey 07110
March 4, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated February 6, 2004, Applicants provide the following remarks.

In response to the requirement for restriction, Applicants elect Group II, claims 1-149 and 267-278, directed to compounds of formula I wherein $R^4$ is thiazole and thiadiazole.

In terms of a species election, Applicants request that the Examiner begin the search for compounds in which $R^2$ is methylsulfonyl, i.e., $SO_2CH_3$. Applicants identify species Example numbers 3, 12, 13, 89 and 97. In these Examples, $R^3$

is cyclopentyl. In Examples 3 and 13, $R^1$ is hydrogen. In Examples 12 and 97, $R^1$ is Cl. In Example 89, $R^1$ is $CF_3$.

Applicants traverse the requirement for restriction, however.

The U.S. Patent Office is required to examine on the merits the entirety of generic claims. Applicants point out that it is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber*, 198 USPQ 328 (CCPA 1978), at pages 331-332:

> "§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis." (Emphasis in original text.)

If the Patent Office were to withdraw applicants' claims in part from further consideration due to an intra-claim restriction, the requirement amounts in fact to a rejection, see *In re Hass*, 179 USPQ 623, 625 (CCPA 1973).

Applicants have the right under U.S. patent law to claim their invention using the limitations that they regard as essential to delineate the invention, as long as the requirements of 35 U.S.C. §112 are met.

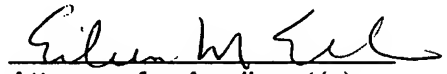
The law does not authorize the U.S. Patent Office to derive its own concept of a generic form of the claimed subject matter and require that it be carved out of existing claims. Applicants have the right under U.S. patent law to claim their invention using the limitations they provide to delineate the invention, as long as the requirements of 35 USC § 112 are met. See *In re Weber* at 331 and *In re Wolfrum and Gold*, 179 USPQ 620, 622 (CCPA 1973).

Also, the Examiner is required to follow the U.S. Patent Office procedures set forth in MPEP § 809. The Examiner must perform a search for all claims readable on the elected species. The elected species should be examined. If the species is patentable, then the next species should be examined, and so forth, until an unpatentable species is found. If no species is found unpatentable, then the generic claim should be allowed.

Applicants request that the intra-claim restriction requirement be withdrawn.

It is believed that no fees are due. If a fee is owing, please charge our deposit account no. 08-2525

Respectfully submitted,



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